

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application in view of the amendments and the remarks to follow. Claims 1-24, 34-44 and 49 were previously canceled and new claims 50-64 have been added. Claims 25-33, 45-48 and 50-64 are pending in this application. Entry of the amendments and reconsideration of the application are requested in view of the amendments and the remarks to follow.

The amendments to the specification update related application data, address minor informalities noted during review and/or bring the drawings and specification into mutual conformance. No new matter is added by the amendments to the specification.

New claims 50-64 are supported at least by text appearing at page 4, line 2 through page 46, line 15 of the substitute application, which corresponds to the application as originally filed. New claims 50-58, 63 and 64 are similar to claims 25-33 but differ in scope, while new claims 59-64 are similar to claims 45-48 but differ in scope. No new matter is added by new claims 50 et seq. New claims 50 et seq. distinguish over the art of record and are allowable.

35 U.S.C. § 103

Claims 25-32 and 45-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,837,635 to Santos et al. (hereinafter "Santos") in view of the IBM Technical Disclosure Bulletin entitled "Host System and Attached Non-Programmable Terminal with Open Parallel Port" (hereinafter "IBM"). Claim 33 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Santos in view of IBM and further in view of U.S. Patent No. 5,796,945 to Tarabella. Applicant respectfully disagrees and requests reconsideration.

Santos is directed (see, e.g., Title) to "A scanning system in which a portion of a preview scan image of a picture displaced on a screen is selected and a corresponding portion of the picture is scanned in a final scan". Santos teaches (see Abstract) that: "An improved scanner is presented which enables a user to preview scan a picture and set out on a screen exactly what portion of the picture he desires to scan. The scanner allows a preview scan of the picture to be made. The preview scan presents a preview image. The user is able to specify what portion of the picture he wants by enclosing that portion of the preview image in a box. Then the scanner performs a final scan which scans only the specified portion of the picture. When performing the final scan, the user may select a percentage amount to reduce or enlarge the image when printed as a printed copy. As the user changes the percentage amount, the dimensions of the resulting printed copy are displayed. The dimensions are calculated by determining the dimensions of the portion to be scanned, and reducing or enlarging the dimensions proportionate to the amount the printed copy is reduced or enlarged."

IBM is directed (see abstract) a method for providing a host system with an application program interface for an open parallel port and an attached non-programmable terminal (NPT) which has an open parallel port.

In contrast, claim 25 recites "For a computer-implemented scanning system having a scanner coupled to a computer, a user interface comprising a graphical window having a preview scan space, the preview scan space being initially empty prior to a time when the scanner scans an image, the user interface progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image", which is not taught, disclosed, suggested or motivated by Santos or IBM, alone or in any proper combination.

The Office Action admits (p. 3) that Santos does not teach an interface that progressively displays an image within a preview scan space. In contrast to the allegations in the Office Action, IBM does not cure these deficiencies. IBM is silent regarding mode of display and that text relating to scan technology referenced within the Office Action merely states:

(p. 475, 1ST paragraph) "Image scanner extensions are also supplied."

(p. 475, last paragraph) "When the user requests an image scan, the host application could fill in a data structure with the following: where to store the image on the host system, maximum size of the image data, scanner type, resolution, and x/y end points of the scan."

(p. 476, lines 2 and 3) "The image scanner API program builds a display data stream based on the content of the data structure."

(p. 476, lines 18 and 19) "When all of the image data has been received, the API program could write the image to a file on the host if requested to do so, fill in

the actual size of the image (which may have been truncated), and return to the calling application."

(p. 477, lines 16 and 17) "The WSC could also receive an event which indicates that the user has cancelled the image scan from Local Scanner Preview Moe."

(p. 478, lines 22 through 25) "The NPT could support a low-resolution Local Scanner Preview mode. Data from the scanner could be displayed in an Online Setup Mode screen so the user can view the scanned image as the compressed data is passed to the WSC. The preview menu could also include Cancel Scan pushbutton which will allow the user to cancel scan processing."

There is simply nothing in these passages that teaches, discloses, suggests or motivates "the user interface progressively displaying the image within the preview scan space to visually convey that the scanner is scanning the image", as recited in claim 25. Additionally, neither reference provides any teaching, disclosure, suggestion or motivation for "the preview scan space being initially empty prior to a time when the scanner scans an image", as recited in claim 25.

Claim 45 recites "An application program interface for an image acquisition system, the application program interface being embodied on a computer-readable medium and having methods for performing the following functions: opening and closing a camera for communication; controlling the camera; reading properties associated with the camera; reading properties associated with pictures taken by the camera; and manipulating pictures stored in a memory of the camera", which is not taught, disclosed, suggested or motivated by Santos or IBM in any proper combination.

More specifically, Santos is void of the term "camera" and thus cannot possibly teach or disclose the subject matter recited in claim 45. IBM similarly is void of the term "camera". The Office Action fails to provide any mention of such as well.

With respect to all of the unpatentability rejections, Applicant notes the requirements of MPEP §2143, entitled "Basic Requirements of a Prima Facie Case of Obviousness" (see also MPEP §706.02(j), entitled "Contents of a 35 U.S.C. 103 Rejection."). MPEP §2143 states that "To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Inasmuch as the reference fails to teach or disclose the elements recited in the claims, the reference cannot provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the reference. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the reference fails to provide all of the features recited in Applicant's claims, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claims.

Claims 26-33 and 46-48 also distinguish by virtue of dependence from allowable claims and for their recitations which are neither taught nor disclosed by the cited references.

The unpatentability rejection of claims 25-33 and 45-48 thus fails the tests noted above. As a result, the rejection of claims 25-33 and 45-48 is clearly prima facie defective and should be withdrawn, and claims 25-33 and 45-48 should be allowed.

Conclusion

Claims 25-33, 45-48 and 50-64 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: Dec. 31, 2003

By: 

Frederick M. Fliegel
Reg. No. 36,138
(509) 324-9256 x239